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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,932	11/28/2001	Masami Horita	MM4485	7359

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EXAMINER	
WATKO, JULIE ANNE	

ART UNIT	PAPER NUMBER
2653	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,932	HORITA ET AL.	
	Examiner	Art Unit	
	Julie Anne Watko	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 12-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-7,12-15 and 17-22* is/are rejected.

7)☒ Claim(s) *4 and 16* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/28/01,08/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. Applicant is advised that should claim 13 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 5-7, 12-15, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Kamata et al (JP 3-144924 A).

Applicant's admitted prior art (see pages 1-2 of the instant specification) teaches all limitations recited in claim 1, except for a weight part balanced with a weight of the actuator, and an adhesive agent provided between the weight part and the movable lens holder so as to bond the weight part to the lens holder in such manner that the adhesive agent and the weight part vibrate together to minimize vibration of said lens holder.

As recited in claim 1, Kamata et al show a weight part (4-1) balanced ("to take the weight balance in the case of tracking control") with a weight of an actuator ("driving device"), and an adhesive agent 7 provided between the weight part and the movable lens holder 3 so as to bond the weight part to the lens holder in such manner that the adhesive agent and the weight part vibrate together to minimize vibration of said lens holder ("relieve or eliminate high-order resonance by fitting a damping member to an objective lens holder via an adhesive member having viscosity").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the weight part and adhesive to the lens holder as taught by Kamata et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to add the weight part and adhesive in order to ensure reliable data reproduction by taking the weight balance in the case of tracking control and focusing control, and by relieving or eliminating high-order resonance as taught by Kamata et al.

All limitations recited in claims 2-3 are either taught by or inherent to Applicant's admitted prior art.

As recited in claim 5, Kamata et al show that the weight part is formed of a rigid body (without rigidity, said weight part would not remain "folded in an L shape"; thus, said weight part is clearly a rigid body).

Kamata et al are silent regarding the claimed location of the weight part; however, it is well established that a change in location of parts does not result in patentability absent unexpected results due to a change in functioning of the apparatus resulting from the change in location. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

As recited in claim 6, Kamata et al show an actuator ("driving device"), a lens 2, a concave part (see Fig. 2) wherein said weight part 4-1 is fitted into said concave part.

Kamata et al are silent regarding the claimed relative locations of parts as recited in claim 6; however, it is well established that a change in location of parts does not result in patentability absent unexpected results due to a change in functioning of the apparatus resulting from the change in location. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Kamata et al are silent regarding the claimed rectangular shape as recited in claim 7; however, it is well established that a change in shape does not result in patentability absent unexpected results due to a change in functioning of the apparatus resulting from the change in shape. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Applicant's admitted prior art shows a lens holder being elastically supported.

As recited in claim 12, Kamata et al show a lens 2 for projecting a light onto a recording medium, a movable lens holder 3 (inherently) supported by a frame and holding said lens 2; a weight part 4-1 fixed to said lens holder, and an adhesive agent 7 provided between the weight part and the lens holder so as to bond said weight part to said lens holder and having

viscoelasticity ("adhesive member having viscosity") such that said weight part serves as a dynamic vibration absorber ("relieve or eliminate high-order resonance by fitting a damping member").

See rationale and motivations for combining teachings above for claim 1.

As recited in claim 13, Kamata et al show an actuator ("driving device") mounted in and driving said lens holder, wherein said weight part "balancer 4-1" is balanced with a weight of said actuator "to take the weight balance".

Regarding claims 14-15: See above for claims 2-3.

Regarding claim 17: See above for claim 5.

Regarding claim 18: See above for claims 12-13.

As recited in claim 20, in addition to the above teachings, Kamata et al show that the weight part is formed of a material having stiffness higher than that of the lens holder (insofar as the lens holder comprises viscoelastic adhesive 7, which is less stiff than rigid balancing weight 4-1).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Kamata et al (JP 3-144924 A) as described above, and further in view of Ezawa et al (US Pat. No. 5663843).

As recited in claim 19, Kamata et al are silent regarding whether said weight part is formed of a material having a specific gravity higher than that of said lens holder.

As recited in claim 19, Ezawa et al teach that a weight part having a specific gravity the same as a lens holder "is light, so that it could not serve as the damper effectively" (see col. 2, lines 59-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a material having a specific gravity higher than that of said lens holder for the weight as taught by Ezawa et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to provide sufficient weight for the weight part to serve effectively as the damper as taught by Ezawa et al.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Kamata et al (JP 3-144924 A) as described above, and further in view of Nagata (JP 2000348358 A).

As recited in claim 21, in addition to the above teachings, Kamata et al are silent regarding the weight part being formed of a metal material.

As recited in claim 21, Nagata shows a weight part being formed of a metal material (solder).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use solder as the weight part as taught by Nagata. The rationale is as follows: one of ordinary skill in the art would have been motivated to ensure quick solidification of the weight part as taught by Nagata.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Kamata et al (JP 3-144924 A) as described above, and further in view of Ujiie et al (US Pat. No. 5781352).

As recited in claim 22, in addition to the above teachings, Kamata et al are silent regarding the weight part being formed of resin material.

As recited in claim 22, Ujiie et al teach the use of adhesive agent as a weight adjusting material, so as to allow the weight of the balancer to be increased (see col. 5, lines 6-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a resin as the weight balancing member as taught by Ujiie et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to use resin in order to increase a balancer weight without causing a loss in weight when solidified as taught by Ujiie et al (see col. 5, lines 6-16).

Allowable Subject Matter

8. Claims 4 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: A person of ordinary skill in the art would not have been motivated to arrive at the recited arrangement of all parts in claims 4 and 16, absent impermissible hindsight reasoning.

Response to Arguments

10. Applicant's arguments with respect to claims 1-7, 12-18 and 21-22 have been considered. Although the arguments are not persuasive (the adhesive of JP 2-135918 is placed between the weight 4 and lens holder 2 insofar as it fills space 2d and covers space 2a, as stated in the second to last paragraph on the 4th page of the translation, "adhesives are dented through passage or slot 2c and slot 2e in 2d of the slots of bore 2b and a radial, and spread on the base of 2a"), they are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ogawa et al (US Pat. No. 6052357) show dynamic vibration absorbers 120 and 121 (see especially Fig. 12).

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on T11A-5PW3P-9PTh11:30A-10PF10A-8:30PSatNoon-8:30P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko
Primary Examiner
Art Unit 2653

February 8, 2006
JAW